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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,623	07/22/2003	Richard Vasichek	15993-115	6587

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EXAMINER	
NINO, ADOLFO	

ART UNIT	PAPER NUMBER
2831	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application No.	Applicant(s)	
	10/624,623	VASICHEK, RICHARD	
	Examiner	Art Unit	
	Adolfo Nino	2831	

-- The MAILING DATE of this communication appears on the cover sh et with the correspondence address --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *13-15 and 20-24* is/are allowed.

6)☒ Claim(s) *1-5,10,11 and 16-19* is/are rejected.

7)☒ Claim(s) *6-9 and 12* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Vaghini (EP 924,830 A1).

Regarding claim 1, Vaghini discloses a bracket (15) for holding a wire (7; fig. 4) adjacent to a magnetic surface ([0014], lines 22-23) of a planar or non-planar configuration comprising: a retaining member (15) having a magnetic attracting end (14) and a retaining end (opposite end to 14), with the retaining member shaped to accept the wire between the magnetic attracting end and the retaining end (fig. 4), with the wire (7) held adjacent to the magnetic surface of the planar or non-planar configuration and constrained between the magnetic attracting end and the retaining end when the magnetic attracting end is held to the magnetic surface of the planar or non-planar configuration by magnetic force (16); with the retaining member formed of a plastic material ([0038], lines 13-14) that is flexible to form a plurality of holding shapes to correspond to the magnetic surface of the planar or nonplanar configuration; and with the plastic material being sturdy to retain one of the plurality of holding shapes while holding the wire adjacent to the magnetic surface of the planar or nonplanar configuration.

Regarding claim 2, Vaghini discloses the bracket (15) of claim 1 with the magnetic attracting end (14) including a magnetic attractor (16) to hold the retaining member to the magnetic surface of the planar or non-planar configuration ([0037]).

Regarding claim 3, Vaghini discloses the bracket (15) of claim 2 with the magnetic attractor (16) being at least one magnet ([0037]).

Regarding claim 10, Vaghini discloses the bracket (15) of claim 1 further comprising, in combination: a groove (15) formed in the retaining member (15) between the magnetic attracting end (14) and the retaining end (opposite to 14), with the groove (15) adapted to engage the wire (7; fig. 4). **Note** that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re. Hutchison, 69 USPQ 138.*

Regarding claim 11, Vaghini discloses the bracket (15) of claim 1 with the retaining member (15) having an arcuate shape (fig. 4) between the magnetic attracting end (14) and the retaining end (opposite end to 14), with the arcuate shape (fig. 4) allowing the wire to be held between the retaining member and the magnetic surface of the planar or non-planar configuration (fig. 4), with the retaining end (opposite end to 14) being free of attachment to the magnetic surface by magnetic force (fig. 4).

Claims 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Beckerich (US 5,357,054).

Regarding claim 16, Beckrich discloses a bracket (57) for holding a wire (27) adjacent to a magnetic surface (14) comprising, in combination: a retaining member (57) having a magnetic attracting end (not marked, but it would be the ends where magnets 58 are attached to) and a retaining end (not marked, but it would be the ends where magnets 58 are attached to), with the retaining member (57) shaped to accept the wire (27) between the magnetic attracting end and the retaining end (fig. 7), with the retaining member having an axis, with the axis extending between the magnetic attracting end and the retaining end of the retaining member (fig. 7); and a first magnetic attractor (58) attached to the magnetic attracting end (fig. 7) of the retaining member (57), with the first magnetic attractor (58) adapted to attach the retaining member to the magnetic surface by magnetic force, with the first magnetic attractor (58) having a length and a width (fig. 9), with the length being longer than the width (fig. 9), with the first magnetic attractor (58) having an elongated magnetic force (fig. 7), with the length of the first magnetic attractor and the elongated magnetic force being generally perpendicular to the axis of the retaining member (fig. 7), with the wire (27) held adjacent to the magnetic surface (14; fig. 7) and constrained between the magnetic attracting end and the retaining end when the magnetic attracting end is held to the magnetic surface by the first magnetic attractor (fig. 7). **Note** that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re. Hutchison, 69 USPQ 138.*

Regarding claim 17, Beckerich discloses the bracket (57) of claim 16 further comprising, in combination: a second magnetic attractor (58) attached to the retaining end of the retaining member (figs. 7, 9), with the second magnetic attractor having a length and a width (fig. 9), with the length of the second magnetic attraction being longer than the width (fig. 9), with the second magnetic attractor having an elongated magnetic force, with the lengths and the elongated magnetic forces of the first and second magnetic attractors being generally perpendicular to the axis of the retaining member (fig. 7).

Regarding claim 18, Beckerich discloses the bracket (57) of claim 17 with both the first magnetic attractor and the second magnetic attractor having rectangular cross sections (fig. 9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vaghini (EP 924,830 A) in view of Helm (US 3,848,227). Vaghini discloses the bracket (15) of claim 2 **except for** further comprising, in combination: an adhesive securing the magnetic attractor to the magnetic attracting end of the retaining member. Helm

teaches that it is known to adhesively secure a magnetic attractor to a surface as set forth at column 2, lines 66-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to adhesively secure magnetic attractor of Vaghini to the magnetic attracting end (14) of Vaghini, as taught by Helm in order to better secure the magnetic attractor to the magnetic attracting end.

Claims 5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaghini (EP 924,830 A).

Regarding claim 5, Vaghini discloses the bracket (15) of claim 2 **except for** the magnetic attractor (14) being two magnets. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the magnetic attractor of Vaghini to be two magnets, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 3 USPQ 8.

Regarding claim 16, Vaghini discloses a bracket (15) for holding a wire (7) adjacent to a magnetic surface (16) comprising, in combination: a retaining member (15) having a magnetic attracting end (14) and a retaining end (not marked, but it would be the opposite end of 14), with the retaining member (15) shaped to accept the wire (7) between the magnetic attracting end and the retaining end (fig. 4), with the retaining member having an axis, with the axis extending between the magnetic attracting end and the retaining end of the retaining member (fig. 4); and a first magnetic attractor (16)

attached to the magnetic attracting end (14) of the retaining member (15), with the first magnetic attractor (16) adapted to attach the retaining member to the magnetic surface by magnetic force, with the first magnetic attractor (16) having an elongated magnetic force (fig. 4), with the length of the first magnetic attractor and the elongated magnetic force being generally perpendicular to the axis of the retaining member (fig. 4), with the wire (7) held adjacent to the magnetic surface (14; fig. 4) and constrained between the magnetic attracting end and the retaining end when the magnetic attracting end is held to the magnetic surface by the first magnetic attractor (fig. 4), **except for** the first magnetic attractor having a length and a width, with the length being longer than the width. It would have been an obvious matter of design choice to have the first magnetic attractor of Vaghini with a length and a width, with the length being longer than the width, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re. Rose, 105 USPQ 237 (CCPA 1955). **Moreover**, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re. Hutchison, 69 USPQ 138.*

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beckerich (US 5,357,054). Beckerich discloses a bracket (57 in fig. 7) for holding a wire (27) adjacent to a magnetic surface (14) comprising, in combination: a retaining

member (57) having a magnetic attracting end and a retaining end (both ends not marked, but are the ends where magnets 58 are attached to), with the retaining member shaped to accept the wire between the magnetic attracting end and the retaining end (fig. 7); a first magnetic attractor (58) attached to the magnetic attracting end; and a second magnetic attractor (58) attached to the retaining end of the retaining member (fig. 7), with the first and second magnetic attractors being adapted to hold the retaining member to the magnetic surface by magnetic force (fig. 7), with the wire (27) held adjacent to the magnetic surface (14) and constrained between the magnetic attracting end and the retaining end when the retaining member is held to the magnetic surface by the first and second magnetic attractors (fig. 7), **except for** the first magnetic attractor being a size different than the second magnetic attractor. It would have been an obvious matter of design choice to have either the first or second magnetic attractor be a size different than the other magnetic attractor, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re. Rose, 105 USPQ 237 (CCPA 1955). **Moreover**, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re. Hutchison, 69 USPQ 138.*

Allowable Subject Matter

Claims 13-15 and 20-24 are allowed.

Claims 6-9 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: With respect to claims 6-9, the cited prior art do not disclose, teach or suggest a bracket formed of a flexible but sturdy plastic material to form a plurality of holding shapes to correspond to the magnetic surface of a planar or non-planar configuration where a magnetic attractor is attached to both ends (retaining and magnetic attracting ends) of the retaining member.

With respect to claim 12, the cited prior art do not disclose, teach or suggest a bracket wherein the magnetic attractor slidingly fits into the magnetic attracting end's cavity with at least a portion of the magnetic attractor being accessible outside of the cavity when the magnetic attractor is mounted and retained within the cavity.

Note that the reasons for the indication of allowable subject matter of claim 12 are the same for the reasons for allowance of claims 13-15.

The following is an examiner's statement of reasons for allowance:

With respect to claims 20-24, the cited prior art do not disclose, teach or suggest a method comprising attaching a first magnet attractive fastener to a nonmagnetic surface; placing a wire adjacent the nonmagnetic surface and the first magnet attractive fastener attached to the nonmagnetic surface; constraining the wire within a bracket; magnetically attaching the bracket to the first magnet attractive fastener while the wire is

constrained within the bracket; removing the bracket; removing the wire; storing the removed wire and the removed bracket; replacing the stored wire; and constraining the replaced wire within the removed bracket; and magnetically reattaching the removed bracket to the first magnet attractive fastener.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tanaka et al. (JP 09159067 A) disclose a magnetic bracket. Winstanley (WO 93/04303) discloses a securing device. Saito et al. (US 6,388,548 B1) disclose a non-contact transformer. Kawata et al. (US 4,565,526) disclose an orthodontic appliance using a magnet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adolfo Nino whose telephone number is (571) 272-1981. The examiner can normally be reached on M-F (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A Reichard can be reached on (571) 272-2800 ext. 31. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AN

Dean A. Reichard 7/2/04

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